

(c) REMARKS

The claims are 1-8 and 12-21 with claim 1 the sole independent claim. The subject matter of claim 11 has been added to claim 1 and dependent claims 9-11 have been cancelled in order to be consistent with this amendment. Reconsideration of the claims is expressly requested.

The Examiner objected to claim 1 under Rule 112, first paragraph, as failing to comply with the enablement requirement. The Examiner was unclear if the element sulfur is present in amounts based on the toner or on the sulfur-containing resin. The Examiner is also unclear whether the at least one element, when present in multiples, is all considered part of the value of T. Finally, the Examiner wished to be advised if the ppm of the at least one element is measured based on the toner particles or on the amount present including that present in the inorganic fine powder.

In response to the Examiner's inquiries, the at least one element, when present in multiples, is measured by T from all the elements present. The ppm of the at least one element is measured from the toner particles as noted in (i) of claim 1 and in specification paragraph [0034]. The "S" value measured in ppm in the claims, is based on that present in the toner particles. Since the amount of the at least one element is now specified and the ratio of amount of the at least one element to the sulfur content (T/S) is specified, then the range of the sulfur content is now also provided by claim 1.

Claims 1-21 were rejected as obvious over Inaba '010 in view of Ohno '152. Inaba is said to teach toner particles containing 100 to 30,000 ppm of an element. Ohno is said to teach a circularity within the claimed invention. The grounds of rejection are respectfully traversed.

Prior to addressing the grounds of rejection, Applicants wish to briefly review certain key features and advantages of the present claimed invention. As recited in amended claim 1, the toner particles contain a specific range of a specified element and a specific ratio range of that element to sulfur. In addition, the toner weight average particle diameter is specified as is the average circularity of the toner. By these features, a toner is provided which exhibits stable charging characteristics in a broad range of environments, forms high quality images, causes less scattering and can be readily removed in a cleaning step.

As noted by the results in Tables 2 and 3 on specification pages 109 and 110, when T is in the claimed range, T/S ratio is in the claimed range, average circularity is in the claimed range and weight average particle diameter of the toner is within the claimed range, enhanced performance is observed.

In Comparative Example 1, no sulfur is present. In Comparative Examples 2 and 3, the content "T" is above 1,000 ppm. In addition, in Comparative Example 2, the T/S ratio was above 30, while in Comparative Example 3, the particle diameter is 2.9 microns or below the claimed range. In Comparative Examples 4-6, T, T/S and either the circularity or weight average particle diameter are beyond the claimed ranges. As shown in Table 3, the present invention provides significantly better performance, while the Comparative Examples exhibit much reduced performance.

Examples 8-10 and Example 14 are now Reference Examples, since their T amount is above the claimed range. The Reference Examples clearly illustrate that as the T amount is increased above 1,000 ppm, performance is progressively reduced.

Inaba merely teaches that the toner particles contain an element in amounts from 100 to 30,000 ppm and, most preferably, from 100 to 9,000 ppm based on the weight of toner particles. In Table 2 of Inaba, in Examples 1-19, the total T amount ranges from 2,250 to 19,500 ppm. Such values are above the present claimed "T" range of from 100 to 1,000 ppm. In Comparative Example 4, the amount of T is 910 ppm, but no sulfur is present. In Comparative Example 5, T is 1200 ppm. This toner was deemed to be a Comparative Example because no sulfur-containing polymer was present. See paragraph [0421] of Inaba.

Inaba fails to teach or suggest the unexpected superiority of the present invention in which the T value is no more than 1,000 ppm. If at all, Inaba teaches that amounts well above 1,000 ppm are preferred with most tested T values being in the range of from 4,000 to 6,000 ppm. The defects of Inaba are not met by Ohno.

Accordingly, it is respectfully requested that the claims be allowed and that the case be passed to issue.

Applicants' undersigned attorney may be reached in our New York office by telephone at (212) 218-2100. All correspondence should continue to be directed to our below listed address.

Respectfully submitted,

A handwritten signature in cursive script, appearing to read "Peter Saxon", written over a horizontal line.

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